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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,617	11/21/2003	Phyllis A. Hannan	58332-8802301	3136
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SPENCER FANE BRITT & BROWNE LLP 1 NORTH BRENTWOOD BLVD. SUITE 1000 ST. LOUIS, MO 63105-3925				
			EXAMINER LEE, EDMUND H	
			ART UNIT 1732	PAPER NUMBER

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding:

Office Action Summary

Application No.

10/719,617

Applicant(s)

HANNAN ET AL.

Examiner

EDMUND H. LEE

Art Unit

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 22-25 is/are pending in the application.
- 4a) Of the above claim(s) 1-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-17, 22-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 15-17 and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Budnik et al (USPN 5851335) in view of Fields et al (USPN 554335) and Harrison (USPN 6313436). In regard to claim 15, Budnik et al teach the basic claimed process including a method for creating a colored engraving (col 3, lns 8-11; col 4, ln 47-col 5, ln 20; figs 1-7); selecting an area to be engraved on the substrate (col 3, lns 8-11; col 4, ln 47-col 5, ln 20; figs 1-7); cutting a groove into the substrate at the area to be engraved, whereby an exposed substrate surface in the groove serves as a substratum on which a coloring agent is deposited (col 3, lns 8-11; col 4, ln 47-col 5, ln 20; figs 1-7); depositing an amount of coloring agent on the substrate surface over the area to be engraved (col 3, lns 8-11; col 4, ln 47-col 5, ln 20; figs 1-7); and heating and melting the coloring agent to cause it to fuse into the substrate surface at the area to leave a colored engraved mark in the substrate (col 3, lns 8-11; col 4, ln 47-col 5, ln 20; figs 1-7). Budnik et al also teaches a desire to minimize color change of the coloring agent during the lasering process, i.e., hue of the coloring agent will approximately be the same throughout the process. See col 8, lns 41-47. Budnik et al, however, do not teach using a ceramic substrate; and using a colored glass frit as the coloring agent. Fields et al teach a method of laser engraving ceramic substrates in order to form a

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colored engraved mark on a ceramic substrate (abstract; col 2, lns 23-31). It should be noted that Fields et al is being provided to merely show the obviousness of laser engraving ceramic substrates. Since Budnik et al and Fields et al are analogous with respect to laser engraving substrates, it would have been obvious to one of ordinary skill in the art at the time the invention was made to engrave a ceramic substrate as taught by Fields et al by the process of Budnik et al in order to form a colored marking fixedly secure to a ceramic substrate. In regard to using a colored glass frit as the coloring agent, Harrison teaches a method of making by laser wherein the marking material is a colored glass frit and the material to be marked is a ceramic (col 7, ln 56- col 8, ln 6). Budnik et al and Harrison are analogous with respect to laser marking a material. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the marking material of Harrison, i.e., the colored glass frit, in the process of Budnik et al (modified) in order to form a highly contrasted marking on a ceramic material. In regard to claim 16, the specific size of a coloring agent is a mere obvious matter of choice dependent on the desired final product and material availability and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, colored glass frits are well-known in the molding art as an effective coloring agent and are readily available in powder form. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use colored glass frit having the claimed size in the process of Budnik et al (modified) in order to diversify the appearance of the colored engraved markings of Budnik et al. In regard to claim 17, such is taught by Budnik et al

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(col 3, lns 8-11; col 4, ln 47-col 5, ln 20; figs 1-7). In regard to claims 22-23, such are taught by Budnik et al. In regard to claim 24, it is well-known in the molding art to increase bond between materials by melting on of the materials. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to melt the underlying layer of the ceramic surface within the groove in order to enhance the bonding between the coloring agent and the ceramic surface of Budnik et al (modified). In regard to claim 25, the specific composition of the ceramic material is a mere obvious matter of choice dependent on the desired final product and material availability and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, ceramics having negligible amount of ferrous oxide are well-known in the art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to a ceramic having the claimed composition in the process of Budnik et al in order to improve the quality of the decorative article.

3. Applicant's arguments with respect to claims 15-17 and 22-25 have been considered but are moot in view of the new ground(s) of rejection.

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents show the state of the art: USPN 5030551; USPN 3463653; USPN 6822192; USPN 5624510; and JP 3-143570.


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDMUND H. LEE whose telephone number is 571.272.1204. The examiner can normally be reached on MONDAY-THURSDAY FROM 9AM-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on 571.272.1196. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EDMUND H. LEE
Primary Examiner
Art Unit 1732

EHL


~~6/11/06~~ 6/12/06.